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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,065	12/16/2003	Vivek V. Thakkar	CML00435N	5211

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Scott M. Garrett  
Motorola, Inc.  
Law Department  
8000 West Sunrise Boulevard  
Fort Lauderdale, FL 33322

EXAMINER

JACKSON, BLANE J

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/737,065	<b>Applicant(s)</b> THAKKAR ET AL.	
	<b>Examiner</b> Blane J. Jackson	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11-13, 15-18, 20, 22, 26, 27 and 34-42 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 10, 14, 19, 21, 23-25 and 28-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 recites the limitation "the first *mobile* communication device" in line 14. There is insufficient antecedent basis for this limitation in the claim. It is suggested that the claim is amended to include the *first mobile and second mobile* communication device with additional language to make clear the system is operating in the cellular environment rather than PSTN.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-8, 11-13, 15, 16-18, 20, 22, 26, 27 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Winseck, Jr. et al. (US 5,493,609).

As to claim 1, Winseck teaches a method of performing mixed mode communications between a first party using a first communication device and second party using a second communication device comprising:

Establishing a communication link between the first and second parties using a first communication mode (figure 1, column 5, lines 15-35),

Receiving an input from the first party at a communication equipment of the first party to establish a second communication link using a second communication mode (the party at the central station activates a data mode or transmission command by pressing a predetermined key, column 5, lines 35-39),

Suspending the first communication mode at the first and second parties communication equipment automatically in response to the input (column 5, lines 39-43),

Commencing a second communication link between the first and second parties using a second communication mode (column 5, lines 45-53),

Terminating the second communication link, and

Upon terminating the second communication link, reestablishing a communication link using the first mode of communication (column 5, lines 53-56).

As to claim 2, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein receiving an input from the first part generates an explicit termination which commences the suspending the first communication mode (figure 2, DCE (14), column 5, line 57 to column 6, line 13).

As to claim 3, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein receiving an input from the first part generates an in-band switch message which commences the suspending the first communication mode (column 5, lines 35-42).

As to claim 4, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein suspending the first communication mode comprises retaining state session information to be used subsequently in commencing the reestablishing the communication link using the first mode of communication (DCE (14) automatically switch between a voice mode and a data mode under control of its DTE (10), column 6, line 63 to column 7, line 10).

As to claim 6, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein establishing the communication link using the first mode of communication is performed by a full duplex telephony mode of communication (figure 1, however via PSTN rather than wireless).

As to claim 7, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein establishing the communication link using the second mode of communication is performed by a data calling mode of communication (column 6, lines 36-61).

As to claim 8, Winseck teaches a method of performing mixed mode communication as defined in claim 7 wherein the data calling mode of communication is performed using packet data (column 6, lines 36-41, facsimile, modem file transfer).

As to claim 11, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein the second communication mode comprises transferring an image file from the first party to the second party (column 5, lines 15-18, share visual data).

As to claims 12 and 13, Winseck teaches a method of performing mixed mode communication as defined in claim 11 wherein the image file includes meta data (since meta-data is definitional data that provides information about other data managed within the environment, a facsimile typically presents the sender defined information such as telephone number and name in text, column 12, line 59 to column 13, line 30).

As to claim 15, Winseck teaches a method of performing mixed mode communication as defined in claim 1 further comprising querying a network identifier of the second party prior to commencing the second communication mode (query in voice mode to determine remote site capabilities, column 13, lines 34-46).

As to claim 16, Winseck teaches a method of performing mixed mode communication as defined in claim 15 wherein the querying is performed upon first establishing the communication link using the first mode of communication (column 7, line 51 to column 8, lines 50-60).

As to claim 17, Winseck teaches a method of mixed mode communication as defined in claim 15 wherein the querying is performed using a circuit data mode of communication (remote unit receives a short data tone burst to and will switch to data mode to respond, column 13, lines 33-46).

As to claim 18, Winseck teaches a method of mixed mode communication as defined in claim 15 wherein the querying is performed using an embedded signaling protocol (column 13, line 46 to column 14, line 51).

As to claim 20, Winseck teaches a method of mixed mode communication as defined in claim 15 wherein the querying comprises requesting the network identifier from the second party (query capability of remote site, column 7, lines

As to claim 22, Winseck teaches a method of performing mixed mode communication as defined in claim 1 wherein terminating the second communication link is performed by sending an explicit termination message (column 5, line 57 to column 6, line 10).

As to claims 26 and 42, Winseck teaches a method of transferring data during a voice call session between a first mobile communication device and a second mobile communication device comprising:

Establishing a voice communication link between the first and second mobile communication devices using a voice communication mode (figure 1, telephones (12) and (22) are representative of PSTN telephones, possibly wireless, column 5, lines 15-35),

Receiving an input at the first communication device to establish a second communication link using a data communication mode (the party at the central station activates a data mode or transmission command by pressing a predetermined key, column 5, lines 35-39),

Suspending the voice communication link (column 5, lines 39-43),

Transferring a data file to the second mobile communication device from the first mobile communication device using the data communication mode (column 6, lines 36-61), and

Automatically resuming the voice communication link (column 5, lines 53-56).

As to claim 27, Winseck teaches a method of transferring data during a voice call session as defined in claim 26 further comprising selecting the data file prior to transferring the data file and after establishing the voice communication link (column 5, lines 15-27).



***Allowable Subject Matter***

Claims 34-41 could be allowed if claim 34 is amended to correct the USC 112 issue and further amended for clarity as a method operating in a (2.5G or 3G) cellular network.

Claims 5, 9, 10, 12-21, 23-25 and 28-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ahmad et al. (US 2002/0082029), Weiner (US 2003/0027566), Alperovich et al. (US 6,317,609), Inoue et al. (US 2004/0077351) and Sacca (US 6,380,967).

Of particular relevance but predated by the applicant's filling date/domestic priority is material recited on page 10 of Farley (2006/0033809).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J. Jackson whose telephone number is (571) 272-7890. The examiner can normally be reached on Monday through Friday, 9:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJJ

  
EDWARD F. URBAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600